

**REMARKS**

This application has been carefully reviewed in light of the present Office Action. The undersigned notes for the record the following matters:

This is a first Office Action and Final Rejection presented by Primary Examiner Becker.

Primary Examiner Becker has apparently replaced Examiner Regan in this application.

Apparently, the multiplicity rejection presented by Examiner Regan has been withdrawn in view of examination of all remaining claims.

Apparently, the rejection under 35 USC 112 has been withdrawn.

Apparently, the indication of allowability of claims 94-101 by Examiner Regan has been withdrawn in favor of new rejections presented in the current action.

Applicants respectfully traverse the present rejections on the following grounds:

**The Office Action is Non-Compliant With 37 C.F.R. §1.104**

The undersigned has reviewed the Office Action in detail, and the newly cited Ginter reference to the extent practical. The undersigned notes that the Office Action calls out the teachings of paragraphs [0140], [0210], [0220], [0223], [2157], [2163] and [2164] as locations in the cited art where the all claim elements called out in each of the 49 currently pending claims may be found. However, the Office Action is deficient in identifying even a single actual element of the cited references on which any of the claim elements in question are to be read. Hence the undersigned is left to guess as to the exact nature of the rejection. It is therefore submitted that the Office Action is not in compliance with 37 CFR 1.104 which requires in part that *"When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."* (Emphasis Added)

It is noted that the present rejection is based on a single reference with 180 columns of text and 87 figures, yet fails to specify even a single specific element of the reference upon which any element of the claims can be read. In view of this deficiency, the undersigned

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respectfully requests that the rejection be explained in detail and the time period for response be restarted if the present rejection is to be maintained. Alternately, if a new rejection is to be presented, the undersigned respectfully requests that the finality of the current rejection be withdrawn.

**Regarding the Rejection Under 35 U.S.C. § 102(e)**

The undersigned has reviewed the rejection in detail and reference to a reasonable extent and presents the following by way of response to the assertion that the claims are anticipated by Ginter. It should be born in mind, however, that in light of the failures noted above, the undersigned has little guidance on how to respond to this action. It is first of all noted that the cited passages of Ginter discuss in broad generalized terms various functions associated with electronic distribution of information within the field of electronic commerce. The undersigned is unable to identify any significantly relevant teachings whatsoever in the cited paragraphs as applied to the claims other than general disclosures relating to electronic commerce.

The Examiner's attention is directed to MPEP 2131 which clearly states in part: "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" and, " 'a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)." It is well established that it is the Examiner's burden to establish *prima facie* unpatentability of the claims, and this burden has not been met in this action.

For purpose of establishing that this is the case, the undersigned will first consider the first independent claim, claim 38.

First considering claim 38, this claim first calls out (to summarize without intent of imposing additional limitations, but to simplify the discussion) that the customer acquires rights to A/V digital content according to a usage rule. The generalized discussions found in Ginter may provide relevant teachings to simply acquiring digital rights to content using electronic

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commerce techniques, and hence may be relevant to certain of the claim features (not an admission), but these features have not been explicitly pointed out in the Office Action.

The claim then calls for "presenting the customer with an opportunity to complete a transaction to acquire additional rights to a selected portion of the A/V content, wherein the selected portion comprises at least one of a soundtrack, a documentary segment, an interview, an audio segment, a video segment and a still image; wherein the customer is presented with the opportunity in a menu displayed at least just prior to, during or just after presentation of the full selection of A/V content; and enabling the customer to store the selected portion if the customer elects to complete the transaction." (Emphasis added\*)

Hence, again to paraphrase without intent of imposing limitations on the claims, in accord with the present claim the customer is provided with a mechanism to acquire further rights to portions of content based upon a second transaction for a portion of content at a time when the full content is fresh on the customers mind (just before, after or during presentation of the full content). This further permits the sale of the content as a result of the immediacy of the customer's interest as a result of use of the full content – an immediacy that may diminish or disappear as time passes. The cited segments of Ginter fail to teach these claim elements or the underlying concepts thereof in the combination claimed, and the undersigned is unable to identify any such teaching in Ginter. If the teaching exists, the Examiner is requested to provide details of such and restart the period for response in order to give Applicants a fair chance to respond.

In view of the above, claim 38, and all claims dependent therefrom, have not been established by the Office Action to be anticipated. Reconsideration and allowance of claims 38-43, 45 and 46 are therefore respectfully requested.

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\* The addition of emphasis to the claim is for no purpose other than to draw the Examiner's attention to that particular aspect of the claim for purposes of the present argument. All claim elements are accorded weight.

Specifically regarding independent claims 48, 72, 84 and 94, each claim contains similar features to those discussed above in connection with claim 38. Thus, the same arguments are applicable and it is submitted that a *prima facie* case of unpatentability has not been established. Accordingly, it is submitted that all claims are allowable for at least the reasons noted above. Reconsideration and allowance of claims 48-54, 56-62, 72-79 and 84-102 are respectfully requested.

**Interview Request**

An interview with Primary Examiner Backer is respectfully requested to further advance the prosecution should Primary Examiner Backer have any remaining issues upon consideration of the above. The undersigned can be reached at the telephone number below. The undersigned will be happy to assist in advancing prosecution of this application and avoiding the necessity of appeal.

Respectfully submitted,

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